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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/996,454
Filing Date: November 20, 2001
Appellant(s): WIRYCZ ET AL.

Robert Touslee
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 10/9/07 appealing from the Office action
mailed 11/27/06

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,291,011	Edlund	9-2001
4,433,022	Schwartz et al	2-1984
4,902,722	Melber	2-1990

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-3, 5-20, 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Edlund, U.S. Patent No. 6,291,011 in view of Melber, U.S. Patent No. 4,902,722.

Edlund discloses a method of producing a fiberglass wallcovering comprising the steps of providing a fiberglass fabric; impregnating the glass fabric with a hydrophilic agent, drying the glass fabric; and subsequently, selectively applying a hydrophobic image coating to a portion of the glass fabric. See claim 1 of Edlund. Edlund does not teach applying a second image coating of expandable material. Melber teaches a syntactic foam material that can be applied to any suitable medium to provide graphic representations (column 2, lines 38-48), including wallcovers and fiberglass (column 7, lines 16-30). The foam of Melber comprises polymeric binder and expandable microspheres (column 3, lines 9-65). It would have been obvious to a person having ordinary skill in the art at the time of the invention to use the image coating step of Melber in addition to the processing steps of Edlund in order to provide a graphic representation to the wallcovering, as taught by Melber. With regard to claims 2, 3, and 5-15, see the dependent claims of the Edlund reference. With regard to claim 16, Melber discloses using acrylic latex binder (Example I). With regard to claims 17 and 18, Melber discloses adding various modifiers to the material (column 3, lines 24-28). Additionally, Melber discloses the foam must be stable (column 1, lines 33-37). It would have been obvious to a person having ordinary skill in the art at the time of the invention to add defoaming agent in

order to better stabilize the expandable material, as desired by Melber. With regard to claim 19, Melber discloses the foam material includes pigment (column 3, lines 11-12). With regard to claim 20, Melber discloses using several different printing methods (column 6, lines 55-57). With regard to claims 23 and 24, Melber teaches the expansion takes place upon the application of heat (column 5, lines 1-5). . With regard to claim 25, Melber teaches microspheres in the claimed amount at col. 6, lines 61-63 and binder in the claimed amounts at table 1 and in example 1. With regard to claim 26, Edlund teaches drying the fiberglass fabric and collecting on a roll. See col. 4, lines 18-21.

Claims 1-3, 5-20, 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Edlund, U.S. Patent No. 6,291,011 in view of Schwartz et al, U.S. patent No. 4,433,022. Edlund discloses a process of coating a fiberglass fabric to make a wallcovering as set forth above. Edlund does not teach applying a second image coating of expandable material. Schwartz et al teaches a three-dimensional printed ceiling board facing material in which a fabric is selectively printed with expandable print paste. Upon heating the expandable coating is substantially increased in size and bonded to the coated substrate, (abstract). The print pastes contain expandable microspheres, (col. 3, lines 59-60). The composition of Schwartz can further include defoamers or thickeners in addition to the binder. See col. 4, lines 7-10. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included the image coating step of Schwartz et al in the process of Edlund, motivated by the expectation of producing a decorative wallcovering with a three

dimensional surface and improved approved appearance. With regard to claim 25, Schwartz teaches that the binder is present in an amount of about 64 percent and the microspheres are present in an amount of about 32 percent. See col. 4, lines 39-45. With regard to claim 26, Edlund teaches drying the fiberglass fabric and collecting on a roll. See col. 4, lines 18-21.

(10) Response to Argument

Appellant argues that there is no motivation to provide a second coating on the fabric of Edlund, since Edlund intends to paint the surface rather than form a decorative foamed pattern on the glass surface. However, it is noted that since the substrate of Edlund is intended to be painted, Edlund does intend for the substrate to be further decorated. Also, Edlund, Melber and Schwartz are all concerned with forming decorative materials. Melber teaches selectively applying the mixture to a variety of substrates in order to impart a decorative appearance to the substrate as does Schwartz. Therefore, the person of ordinary skill in the art would have been motivated to apply the coating of Melber or Schwartz to the substrate of Edlund with the expectation that this would further enhance the decorative appearance of the wallcovering of Edlund. Melber teaches that the coating can be applied discontinuously to substrates in only the desired areas, such as by stenciling or silk screening, or that portions of the coating could be applied and then removed. (see col. 6, lines 35-60). Therefore, the three dimensional coating of Melber could be applied in discrete areas to form a three dimensional image or pattern to further enhance the appearance of the fabric of Edlund, without covering all the areas of different hydrophilicity and

hydrophobicity. Finally, it is noted that there is nothing which would preclude the three-dimensionally imaged wallcovering to be painted.

Appellant argues that there must a teaching, suggestion or motivation to combine the references. However, KSR forecloses the argument that a specific teaching, suggestion, or motivation is required to support a finding of obviousness. See the recent Board decision *Ex parte Smith*, --USPQ2d--, slip op. at 20, (Be. Pat. App. & Interf. June 25, 2007) (citing KSR, 82 USPQ2d at 1396) (available at <http://www.uspto.gov/web/offices/dcom/bpai/prec/fd071925.pdf>). Also, as set forth above, all the references applied are drawn to forming decorative materials and therefore, the teachings of Schwartz and Melber would have been relevant to the disclosure of Edlund, since both secondary references provide ways in which the appearance of the wallcovering could be further enhanced.

Appellant argues that there is not a reasonable expectation of success for combining the teachings of Edlund and Melber, because applying the three-dimensional coating of Melber would cover up the hydrophilic areas of Edlund, which are designed to be painted by the consumer. However, as set forth above, Melber teaches that the coating can be applied discontinuously by stenciling or silk screening to only selected areas of the substrate, which would enable the application of the coating to only the desired regions of Edlund. Further, it is noted that there is nothing on the record to show that the material of Melber could not be painted after application to the treated substrate of Edlund.

Appellant argues that the application of the coating of Melber to the treated substrate of Edlund would change the principle of operation of Edlund, since Edlund is intended to be painted and to display a decorative pattern due to the hydrophilic and hydrophobic regions of the treated substrate. However, Melber teaches selectively applying the three dimensional coating to substrates such as fiberglass. Therefore, the person of ordinary skill would have been able to select certain regions of the substrate of Edlund to apply the coating to, without applying it over the entire substrate, which would enable the decorative effects of the treated substrate of Edlund to be present in the uncoated areas, thus further enhancing the appearance of the wallcovering. Also, it is noted that there is nothing to prevent the three dimensional image of Melber from also being painted.

Appellant argues that Example 1 of Melber does not include expandable microspheres and that Examples 2-4 do not include a binder. However, Melber teaches that in any coating, the pre-expanded microspheres can be replaced with unexpanded, expandable microspheres. See col. 8, lines 1-56. Further, Melber teaches in Table 1 that the compositions of the expandable coating typically contain a binder, Example 1 teaches employing an acrylic latex binder, and the claims of Melber also require a binder. Therefore, it is clear that Melber employs a binder.

Appellant argues that addition of pre-expanded microspheres would materially affect the basic and novel characteristics of the presently claimed process. However, there is nothing on the record which shows that the presence of pre-expanded

microspheres would have a material affect on the basic and novel characteristics of the present claimed process. Also, it is noted that Melber states that a portion of the unexpanded microspheres can be replaced with the pre-expanded microspheres, but Melber does not require the substitution. See col. 8, lines 3-43.

With regard to claim 25, Appellant argues that Melber does not teach the claimed amounts of microspheres and binder. However, ,Melber teaches microspheres in the claimed amount at col. 6, lines 61-63 and binder in the claimed amounts at table 1 and in example 1.

With regard to the rejection over Edlund in view of Schwartz, Appellant argues that Schwartz does not disclose the step of adding the expandable coating to an already treated substrate. However, Schwartz teaches applying a decorative coating selectively or discontinuously to substrates such as fiberglass. While it is acknowledged that Schwartz does not teach the claimed steps (a) - (d) as set forth in claim 1, (since if it did Schwartz would anticipate the claims), the combination of Edlund and Schwartz does teach all the claimed limitations.

Appellant argues that there is no motivation to apply the coating of Schwartz to the fabric of Edlund because the prior art must contain a teaching, suggestion or motivation to modify or combine the references. However, KSR forecloses the argument that a specific teaching, suggestion, or motivation is required to support a finding of obviousness. See the recent Board decision Ex parte Smith, --USPQ2d--,slip op. at 20, (Be. Pat. App. & Interf. June 25, 2007) (citing KSR, 82 USPQ2d at 1396) (available at <http://www.uspto.gov/web/offices/dcom/bpai/prec/fd071925.pdf>). Also, as

set forth above, all the references applied are drawn to forming decorative materials and therefore, the teachings of Schwartz and Melber would have been relevant to the disclosure of Edlund, since both secondary references provide ways in which the appearance of the wallcovering could be further enhanced.

Appellant argues that the motivation to combine the references can only come from the instant disclosure. However, Edlund, Melber and Schwartz are concerned with forming decorative materials. Schwartz teaches selectively applying the mixture to a variety of substrates in order to impart a decorative appearance. Therefore, the person of ordinary skill in the art would have been motivated to apply the coating of Melber or Schwartz to the substrate of Edlund with the expectation that this would further enhance the decorative appearance of the wallcovering of Edlund.

Appellant argues that the application of the coating of Schwartz to the treated substrate of Edlund would change the principle of operation of Edlund, since Edlund is intended to be painted and to display a decorative pattern due to the hydrophilic and hydrophobic regions of the treated substrate. However, Schwartz teaches selectively applying the three dimensional coating to substrates such as fiberglass in those areas of the fabric where a three dimensional pattern is desired. See col. 1, lines 65 – col. 2, line 3. Therefore, the person of ordinary skill would have been able to select certain regions of the substrate of Edlund to apply the coating to, without applying it over the entire substrate, which would enable the decorative effects of the treated substrate of Edlund to be present in the uncoated areas, thus further enhancing the appearance of

the wallcovering. Also, it is noted that there is nothing to prevent the three dimensional image of Schwartz from also being painted.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Elizabeth M. Cole/

Primary Examiner, Art Unit 1794

Conferees:

/Romulo H. Delmendo/

/Rena L. Dye/

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